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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,965	09/26/2003	Eurell Thomas Eubanks	80021	3602

7590 11/15/2006

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EXAMINER

CHAN, SING P

ART UNIT PAPER NUMBER

1734

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,965

Applicant(s)

EUBANKS ET AL.

Examiner

Sing P. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-21,47-50 and 70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,7 and 70 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9-21 and 47-50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/31/06</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-5, 8, 9, 13-17, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Narayanan (U.S. 6,162,492).

Regarding claims 1, 3, and 4, Narayanan discloses a method of using a correction material to covering over mistake. The method includes providing multi-layer correction material comprising a pigmented covering film that can be inscribed and stripped off on a carrier with a coating of adhesive (Col 1, lines 64-65), positioning the correction material over the mistake, such as writing or typing or drawing, to be corrected or covered up on a substrate, and exert pressure to the carrier, stripping the carrier with the pigmented covering film remained adhered to the correction point on the substrate and cover the writing or typing or drawings lying underneath (Col 1, lines 22-32) and continue typing or painting again if needed (Col 1, lines 13-15), which substantially cover all of the substrate and the covering film. Narayanan recites the covering of mistake such as writing, typing or drawing, which required the substrate to includes paper and the examiner is interpreting the recitation of wallpaper, wooden

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material or wooden-composite material to include paper, since wallpaper is paper and furthermore, paper is formed from wood fibers therefore, is a wooden material.

Regarding claim 5, Narayanan discloses the typing on the substrate (Col 1, lines 13-15), which required a typewriter and will orient the substrate or paper in a substantially vertical position.

Regarding claim 8, Narayanan discloses the method is for covering mistake in writing or typing or drawing (Col 1, lines 13-15), which typically on substrate such as paper and is formed of wood fibers.

Regarding claim 9, Narayanan discloses the mistake includes writing (Col 1, lines 13-15), which includes writing with an ink pen or marking pen.

Regarding claims 13-15, Narayanan discloses the mistake is the writing or typing or drawing (Col 1, lines 13-15), which are on the surface of the substrate or in or on the paint layer on the substrate.

Regarding claims 16 and 17, Narayanan discloses the drawings with mistake are repainted (Col 1, lines 13-15), which required paint and includes paints with dye and organic solvent.

Regarding claims 20 and 21, Narayanan discloses a covering film for writing, typing or drawings, which the film prevents migration of the ink or dye or coloring and solvent through the film layer.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10-12, 18, 19, 47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanan (U.S. 6,162,492) as applied to claim 1 above, and further in view of Rutz et al (U.S. 5,891,562).

Narayanan as disclosed above is silent as to the cover film is applied to cover materials that are hydrophilic, lipophilic, food residue, mineral oil, petrolatum, or wax and applying the cover film by using a roller with uniform pressure across the surface of the transfer tape or composite. However, applying the covering film to writing, marks, or illustrations with a covering film and applying the film with a roller with uniform pressure across the surface of the transfer composite is well known and conventional as shown for example by Rutz et al. Rutz et al discloses a method of correcting writing, marks, and illustrations (Col 8, lines 15-18). The method includes providing a transfer tape with a flexible backing, a pigment plastic layer or film and an adhesive layer (Col 1, lines 60-67), applying the transfer tape to substrate with a hand roller (Col 9, lines 56-62), which provides a uniform pressure to the backing. Furthermore, one of ordinary skill in the art reading and applying the method of Rutz et al would appreciate logically any marks

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would be capable of being covered by the transfer tape or covering film such as food residue, lipophilic, or hydrophilic material spilled onto the substrate.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a roller to applying a uniform pressure to the transfer tape as disclosed by Rutz et al and to logically cover any marks such as food residue, lipophilic, or hydrophilic material in the method of Narayanan to provide a quick and uniform application of a cover film with user can immediately write on. (See Rutz et al, Col 9, lines 56-60)

5. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanan (U.S. 6,162,492) as applied to claim 1 above, and further in view of Sakurai (GB 2,196,580).

Narayanan as disclosed above is silent as to the applying the covering film with a spatula. However using a spatula to apply a covering film from a transfer tape is well known and conventional as shown for example by Sakurai. Sakurai discloses a method of applying error correction tape. The method includes rubbing the base tape or backing with a ball point pen or spatula to transfer the covering film to the substrate. (Page 1, lines 62-80)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the covering film with any means such as a ball point pen or a spatula as disclosed by Sakurai in the method of Narayanan to provide any means, which are functionally equivalents.

Allowable Subject Matter

6. Claims 6, 7, and 70 are allowed.

Response to Arguments

7. Applicant's arguments filed September 14, 2006 have been fully considered but they are not persuasive.

8. Claim 1 recites the substrate comprises one or more of a plastered wall, wallboard, particle board, lumber, wooden material or wooden-composite material used in the construction of dwellings or commercial buildings, concrete, or wallpaper, wherein the recitation of wallpaper, wooden material or wooden-composite material to include paper, since wallpaper is paper and furthermore, paper is formed from wood fibers therefore, is a wooden material or a composite material. The reference Narayanan does disclose the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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